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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,925	03/06/2002	Toshio Kitamura	06501-102US1	1474
26161	7590	03/25/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ANDRES, JANET L	
			ART UNIT	PAPER NUMBER
			1646	14
DATE MAILED: 03/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092,925

Applicant(s)

KITAMURA ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 15, 16 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 14, 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

In response to a telephone call from Applicant's representative Marcos Reavis on 22 March 2004 indicating that the sequence alignment supposedly attached to the previous office action was not mailed, the relevant rejection and sequence alignment are presented below. A clarification of the denial of priority is also presented.

#### ***Priority***

Applicant's priority claim to PCT JP00/06050 and Japanese Application 11-252910 is acknowledged. The foreign priority document has been received; however, since no utility for the invention is disclosed in these documents (see below), the priority documents are not enabling under 35 U.S.C. 112. See MPEP §2163.03:

Under 35 U.S.C. 119 (a) or (e), the claims in a U.S. application are entitled to the benefit of a foreign priority date or the filing date of a provisional application if the corresponding foreign application or provisional application supports the claims in the manner required by 35 U.S.C. 112, first paragraph.

Since the priority documents do not meet the requirements of 35 U.S.C. 112, the priority date granted is the filing date of the instant application, 6 March 2002.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-10, 13, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,008,022 (Su et al., 1999).

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The '022 patent teaches SEQ ID NO: 1, which contains regions of >80% similarity and would hybridize under stringent conditions. See sequence alignment attached to document. It further encodes "a fragment" of SEQ ID NO: 2; no fragment size is specified. In addition, claim 17 requires no hybridization conditions and any DNA molecule will hybridize to any other under sufficiently mild conditions. Expression is taught in columns 15-19.

## Sequence alignment:

```
US-08-820-970-1
; Sequence 1, Application US/08820970
; Patent No. 6008022
; GENERAL INFORMATION:
;   APPLICANT: LI, YI
;   APPLICANT: SU, KUI
;   APPLICANT: LI, HAODONG
;   TITLE OF INVENTION: HUMAN CYTOKINE POLYPEPTIDE
;   NUMBER OF SEQUENCES: 9
;   CORRESPONDENCE ADDRESS:
;     ADDRESSEE: HUMAN GENOME SCIENCES, INC.
;     STREET: 9410 KEY WEST AVENUE
;     CITY: ROCKVILLE
;     STATE: MARYLAND
;     COUNTRY: USA
;     ZIP: 20850
;   COMPUTER READABLE FORM:
;     MEDIUM TYPE: Floppy disk
;     COMPUTER: IBM PC compatible
;     OPERATING SYSTEM: PC-DOS/MS-DOS
;     SOFTWARE: PatentIn Release #1.0, Version #1.30
;   CURRENT APPLICATION DATA:
;     APPLICATION NUMBER: US/08/820,970
;     FILING DATE: 20-MAR-1997
;     CLASSIFICATION: 435
;   ATTORNEY/AGENT INFORMATION:
;     NAME: Brookes, Anders, A.
;     REGISTRATION NUMBER: 36,373
;     REFERENCE/DOCKET NUMBER: PF270
;   TELECOMMUNICATION INFORMATION:
;     TELEPHONE: 301-309-8504
;     TELEFAX: 301-309-8512
;   INFORMATION FOR SEQ ID NO: 1:
;     SEQUENCE CHARACTERISTICS:
;       LENGTH: 780 base pairs
;       TYPE: nucleic acid
;       STRANDEDNESS: single
```

Query Match 13.3%; Score 528.4; DB 3; Length 780;  
Best Local Similarity 82.6%; Pred. No. 1.1e-130;  
Matches 631; Conservative 0; Mismatches 126; Indels 7; Gaps

2;

Qy	23	GGCGGCCGGGAGGAGGCCGGGGCCACGTTCTTGGAAAGCTACTGAGTGACTTCTTTGAAG	82
Db	8	GGCGACTTCGCGGGACCGTGGCGCATGTTTCCTGGGAGTTACTGATCATCTTCTTTGAAG	67
Qy	83	AACCATGAAGTCACACTATAT---TGTGCTAGCTCTAGCCTCCCTGACGTTTCTGCTGTG	139
Db	68	AAACATGAAGTTACACTATGTTGCTGTGCTTACTCTAGCCATCCTGATGTTTCTGACATG	127
Qy	140	TCTCCCCGTGTCCCAGAGCTGTAACAAAGCACTCTGTGCCAGCGATGTGAGCAAATGCCT	199
Db	128	GCTTCCAGAATCACTGAGCTGTAACAAAGCACTCTGTGCTAGTGATGTGAGCAAATGCCT	187
Qy	200	CATT CAGGAGCTCTGCCAGTGCCGGCCTGGAGAAGGGAAGTCCCCCTGCTGTAAGGAGTG	259
Db	188	CATT CAGGAGCTCTGCCAGTGCCGGCCGGGAGAAGGCAATTGCTCCTGCTGTAAGGAGTG	247
Qy	260	CATGCTGTGCCTCGGGGCCCTGTGGGACGAGTGCTGCGACTGTGTGGTATGTGCAACCC	319
Db	248	CATGCTGTGTCTTGGGGCCCTTTGGGACGAGTGCTGTGACTGTGTTGGTATGTGTAATCC	307
Qy	320	TCGGAATTACAGCGACACCCCGCCACATCCAAGAGCACCGTGGAGGAGCTGCACGAGCC	379
Db	308	TCGAAATTATAGTGACACACCTCCAACCTCAAAGAGCACAGTGGAGGAGCTGCATGAACC	367
Qy	380	CATTCCGTCCCTGTTCAGGGCGCTGACGGAGGGCGACACCCAGCTGAACTGGAACATCGT	439
Db	368	GATCCCTTCTCTCTTCCGGGCACTCACAGAAGGAGATACTCAGTTGAATTGGAACATCGT	427
Qy	440	CTCCTTCCCTGTGGCAGAGGAGCTGTACACCATGAAAACCTAGTCTCCTTCCTAGAAAC	499
Db	428	TTCTTTCCTGTGTGAGAAGAACTTTCACATCATGAGAATCTGTTTTATTCTTAGAAAC	487
Qy	500	TGTGAACCAGCTGCACCACCAAACGTGTCTGTTCCAGCAACAATGTCCACGCCCCCTT	559
Db	488	TGTGAACCAGCCACACCACAGAATGTGTCTGTCCCCAGCAATAATGTTTCACGCGCCTTA	547

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Qy	560	CCCCAGCGACAAAGAGCGCATGTGCACAGTGGTTTACTTTGATGACTGCATGTCCATCCA	619
Db	548	TTCCAGTGACAAAGAACACATGTGTACTGTGGTTTATTTTGATGACTGCATGTCCATACA	607
Qy	620	CCAGTGTAAGATATCCTGCGAATCCATGGGTGCATCCAAGTATCGCTGGTTTCACAACGC	679
Db	608	TCAGTGTAATAATATCCTGTGAGTCCATGGGAGCATCCAAATATCGCTGGTTTCATAATGC	667
Qy	680	CTGCTGCGAGTGCATCGGTCCAGAGTGCATTGACTATGGGAGTAAAAGTGTCAAGTGTAT	739
Db	668	CTGCTGCGAGTGCATTGGTCCAGAATGTATTGACTATGGTAGTAAAAGTGTCAAATGTAT	727
Qy	740	GAAGTGCATGTTTTAAAGAGGGGGAAGAAATGCAAACCAAAGCA	783
Db	728	GAAGTGCATGTTTTAAAGAAG----ACAAATGCAAACCAAAGCA	767

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday-Thursday and every other Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D.

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22 March 2004

  
JANET ANDRUS  
PATENT EXAMINER